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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,556	03/05/2001	Radik Ismagilov		4086

7590 06/16/2005
Radik Ismagilov
4200 Artesia Blvd. #43
Torrance, CA 90504

EXAMINER

HOYE, MICHAEL W

ART UNIT PAPER NUMBER

2614

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,556

Applicant(s)

ISMAGILOV, RADIK

Examiner

Michael W. Hoye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment to the claims filed on 12/17/04 does not comply with the requirements of 37 CFR 1.121(c) because the claim listing should begin on a separate sheet (see section 1 below), claim 1 should be listed indicating the status of the claim (i.e. “1. (currently amended) ...” or claim 1 should be canceled and written as a new claim, i.e., “3. (new) ...”) and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claim (see section 2 below - *When claim text with markings is required*). In addition, new claim 2 added by amendment must be indicated with the status of “new” and presented in clean version, i.e., without any underlining (see section 3 below). Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) Claim listing. All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) When claim text with markings is required. All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter

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must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

2. The amendment filed on 12/17/04 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In the BACKGROUND OF THE INVENTION section of the specification, the following underlined portions in the newly proposed amendment were not supported by the original disclosure:

“My invention comes extremely helpful in this case. Customer turns on a hotel room television, tunes into a channel with icons of participating restaurants that offer late night dining options. With the help of a remote control, the customer scrolls through the list until the desired choice is found. When that icon is selected, a food and beverage menu will appear.

allowing the customer to view all the choices. When the final decision is made, customer will be given the approximate wait time and balance due.

Customer places the order when ORDER button is pressed on the remote control. Information then goes through C-changer (the device which transmits analog signal to the digital) for example at the hotel to server and on to participating vendor."

And the last paragraph before the listing of claims which states:

"My invention prevents a need to purchase additional equipment or necessity to manufacture new equipment to service the purpose. This concept makes the application of my invention accessible to numerous enterprises, hotels, resorts as well as private parties practically immediately."

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

3. Applicant's arguments filed on 12/17/04 have been fully considered but they are not persuasive.

Regarding claim 1, the Applicant argues that, "Concerning [the] Wilcox patent I can say that their idea...looks like mine but it is different. Their idea is to make some device which will do the interactive connection by itself. They want to put inside all the devices to be able to do this connection. I don't need it. The customer can place an order right now using any digital cable/dish box with [a] remote control. I need just one extra device to transfer [an] analog signal to digital. But I don't have to put this device inside the cable/dish box. I can use it separate. So my idea is different and more general."

In response the Examiner respectfully disagrees because the Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define

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a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., one extra device to transfer an analog signal to digital that is separate from the cable/dish box) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As an additional note for any future correspondence, the Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the Examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Specification

4. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

(7 CFR 1.72(b) requires that the abstract be set forth on a separate sheet. This requirement applies to amendments to the abstract as well as to the initial filing of the application.)

5. The following is an outline of the proper format of a Specification:

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (d) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (e) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (f) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not

necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (g) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (h) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

Claim Objections

- 6. Claim 2 is objected to because of the following informalities: in line 1 of the claim, the word “the” should be --an--, in line 2 of the claim, the word “the” should be deleted or canceled from the claim language, and in line 3 of the claim, the words, “other vendors and dinning places; any products and other goods” should be worded as --other vendors and dinning places, any products, or other goods--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed subject matter related to, "Wireless and handhelds" is not described in the specification. The Examiner is uncertain as to how the claimed, "wireless, PDAs, handhelds or pocket PCs" are used in the invention.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 2 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim is narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim must be in one sentence form only. Note the format of the claims in the patents cited.

Regarding claim 2, the phrase "...any products and other goods, using a remote control device of a TV set, cable box, satellite dish network box, wireless, PDAs, handhelds or pocket PCs" renders the claim indefinite because it is unclear whether one of or more than one of the

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limitations following the phrase are part of the claimed invention. The Examiner is uncertain as to what the words “wireless” and “handhelds” are referring to. See MPEP § 2173.05(d).

The Examiner suggests (at least) the following language for claim 2:

2. (new) An order-delivery system via interactive systems that will allow potential customers to access menus of fast food restaurants, other vendors and dining places, any products or other goods,

using a remote control device of at least one of a TV set, a TV set and a cable box, a TV set and a satellite dish network box, a PDA, or pocket PC.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilcox et al. (USPN 6,678,891), cited by the Examiner.

As to claim 1, note the Wilcox et al. reference which discloses the claimed system for facilitating an order-delivery service via interactive systems (see Abstract). The claimed order-delivery service comprising: at least one of a TV set and cable box, or a TV set and a satellite dish network is met by set-top box or client terminal 9 and TV 11 (see Figs. 1 and 2, and col. 14, lines 24-37), that allows potential customers to accesses menus of restaurants, and allows a user

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to order and receive a fast delivery (see Figures 26-59 – related to ordering a pizza, also see Figs. 60-72). The claimed using a remote control device is met by viewer input device 13, which may be a wireless remote (see Figs. 1-2 and col. 11, lines 52-61). The claimed using the remote control device for the one of the TV set and the cable box, or the TV set and satellite dish network box is met by TV set 11 and client terminal or cable box 9 (see Figs. 1 and 2, col. 10, lines 25-34; col. 11, lines 51-61 and col. 14, lines 24-67).

As to claim 2, note the Wilcox et al. reference which discloses the claimed order-delivery system via interactive systems that will allow potential customers to access menus of fast food restaurants, other vendors and dining places, any products or other goods (see Abstract). The claimed using a remote control device of one of a TV set and the cable box, or the TV set and satellite dish network box is met by TV set 11 and client terminal or cable box 9, and viewer input device 13, which may be a wireless remote (see Figs. 1 and 2, col. 10, lines 25-34; col. 11, lines 51-61 and col. 14, lines 24-67), where customers may access menus of restaurants, and order and receive a fast delivery (see Figures 26-59 – related to ordering a pizza, also see Figs. 60-72).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McNally et al (USPN 6,871,325) – Discloses an information management system and method which allows a user to place orders though menus using wired, wireless and Web-based systems, including a digital input device or remote pager.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael W. Hoyer whose telephone number is (571) 272-7346. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (571) 272-7353.

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Hand-delivered responses should be brought to:

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **(571) 272-2600**.

Michael W. Hoyer
June 2, 2005


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600